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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,798	03/08/2000	Richard Rothkopf	2470-104A	2139

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EXAMINER	
CARLSON, JEFFREY D	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/520,798	ROTHKOPF, RICHARD	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13,15-21 and 23-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,15-21 and 23-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to the papers filed 9/11/06.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

Examiner considered the 131 affidavit filed 9/22/05 and determined in the Office Action mailed 3/10/06 that the affidavit was not persuasive due to a lack of

demonstrated diligence. Examiner stated that there was a lack of evidence to support the claims of diligent activity. As applicant has pointed out, the MPEP 715.07 (*Ex parte Hook)* does not require the corroboration for the averments made in a 131 affidavit.

With this in mind, the 131 affidavit can be said to aver that during the period necessary for diligence, applicant "reviewed and provided comments on the draft patent application." It is also clear from the record that applicant executed the declaration and assignment on 2/25/2000. Aside from 2/25/2000, there is no position, averred or corroborated, regarding when or how often the supposed diligent activity occurred. All of the noted acts could have been performed on 2/25/2000, leaving substantial gaps of time without any apparent diligent acts. Further, MPEP 715.07 II states "**the actual dates of acts relied on to establish diligence must be provided.**" MPEP 715.07 III states that applicant "**must also show diligence...continuously up to the date of...filing**." "[I]t is not enough merely to allege that applicant...had been diligent" MPEP 715.07(a).

MPEP 2138.06 states:

> An applicant must account for the **entire period** during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) **(statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal**. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (**37 CFR 1.131** issue);

At this point, the time period from prior to 1/21/2000 to 3/8/2000 has not been sufficiently demonstrated to have elapsed with due diligence. The declaration filed 9/22/05 is thereby not persuasive.

Art Rejections

The basis for the Office Action mailed 3/31/2005 rejecting the pending claims is being repeated herein:

3. Claims 1-3, 7-12, and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Adams et al (US2003/0083943).

Claims 1 and 10: Adams discloses a method and apparatus for offering a promotional award to a visitor of an electronic commerce site, comprising:

a. storing a customer identifier for each visitor to the site (page 8, paragraph 0062 and pages 9-10, paragraph 0075);

b. storing information pertaining to the number of visits to the site by the visitor identified by the customer identifier (page 8, paragraph 0062 and pages 9-10, paragraph 0075);

c. storing award rules (criteria) for crediting awards to visitors of the site (page 5, paragraph 0049 and page 8, paragraph 0062);

d. granting an award to a visitor identified by the customer identifier based on the visitor's compliance with the stored award rules (page 8, paragraphs 0062 and 0064).

Claim 2: Adams discloses an apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claim 1 above, and further discloses the award criteria comprising the number of previous visits to the site by that visitor (page 6, paragraph 0054 and page 8, paragraphs 0065-0066).

Claim 3: Adams discloses an apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claim 1 above, and further discloses the award criteria comprising the length of time since the previous visit to the site by the visitor (page 8, paragraphs 0065-0066)

Claims 7, 11, and 12: Adams discloses a method and apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claims 2 and 10 above, and further discloses increasing (or varying) the award value with each successive visit to the sire by the visitor (page 5, paragraph 0049 and page 8, paragraphs 0065-0066).

Claims 8 and 16: Adams discloses a method and apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claims 1 and 10 above, and further discloses crediting the promotional award (award points) to a purchase price of a purchase by the visitor (page 6, paragraph 0053).

Claims 9 and 18: Adams discloses a method and apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claims 1 and 10 above, and further discloses the connecting to the electronic commerce site through the Internet (page 8, paragraph 0062).

Claim 17: Adams discloses a method for offering a promotional award to a visitor of an electronic commerce site as in Claim 10 above, and further discloses the visitor selecting the promotional award (page 8, paragraph 0067).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 4-6, 13, 15, 19, 20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al (US 2003/0083943) in view of Steinman et al (US 2003/0105663).

Claims 4, 5, 13, 15, and 19: Adams discloses a method and apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claims 1 and 10 above and further discloses accumulating a total value of awards (page 5, paragraph 0047), but does not explicitly disclose that the current award is determined based on the cumulative value of the previous awards nor that an award limit is set. However, Steinman discloses a similar apparatus for offering a promotional award to a visitor of an electronic commerce site in which the value of the award is determined by the length of time since the previous award or based on the total accumulative value of previous awards and a limit is set for the amount of awards one visitor may be granted during a predetermined time period (e.g. Steinman discloses that the amount of the

award may be decreased to the difference between the current award total and the award limit for that time period; e.g. 100 point daily limit)(page 3, paragraph 0031). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to base the value of the current award in Adams on the total accumulated value of previous awards. One would have been motivated to use such a criteria in Adams in order to limit the financial liability of the award issuer. Without such a cap or limit on the amount of awards a visitor may accrue, the award issuer could accumulate millions of dollars in liabilities when a great number of visitors "run up" a large number of awards within a short amount of time.

Claim 6: Adams and Steinman discloses an apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claim 5 above, and Steinman discloses setting an award limit. Adams further discloses the accumulate value of the awards are reduced when the visitor makes a purchase at the site using the award points (page 6, paragraph 0055). While it is not explicitly disclosed that the award limit is set back to zero, it would have been obvious to one having ordinary skill in the art at the time the invention was made that if the visitor redeemed all of his accumulated award points, the award limit would be reset to zero upon the updating of the accumulated awards file. One would have been motivated to reset the award limit in order to allow the visitor to accumulate more awards, thus enticing the visitor to visit the electronic commerce site again in the future.

Claims 20 and 23: Adams and Steinman disclose a method and apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claims 2 and 10 above, and Adams further discloses increasing (or varying) the award value with each successive visit to the sire by the visitor (page 5, paragraph 0049 and page 8, paragraphs 0065-0066).

Claim 24: Adams and Steinman disclose a method for offering a promotional award to a visitor of an electronic commerce site as in Claim 10 above, and Adams further discloses the visitor selecting the promotional award (page 8, paragraph 0067).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc